

ATTACHMENT B

Ex parte Lenoine

U.S. Patent and Trademark Office
Board of Patent Appeals and Interferences

Ex parte Lenoine

No. 94-0216

Decided December 27, 1994

Released March 12, 1998

PATENTS

1. Practice and procedure in Patent and Trademark Office — Board of Patent Appeals and Interferences — Jurisdiction (§110.1103)

Word "claims", in 35 USC 134, which provides that patent applicant, "any of whose claims have been twice rejected," may appeal from decision of primary examiner to Board of Patent Appeals and Interferences; should he be construed consistently with its use in 35 USC 132 to mean "claims for a patent," rather than particular "claims of an application."

2. Practice and procedure in Patent and Trademark Office — Board of Patent Appeals and Interferences — Jurisdiction (§110.1103)

Board of Patent Appeals and Interferences has jurisdiction over appeal filed by applicant who was denied patent three times, since 35 USC 134 provides that applicant may appeal if applicant's "claims" have been twice rejected, since term "claims" in this context properly construed to mean "claim for a patent" as used in 35 USC 132, rather than particular "claim of an application," and since applicant therefore may file appeal provided applicant has twice been denied patent.

Appeal from rejection of all claims in patent application.

Patent application of Philippe Lenoine, serial no. 07/884,875, filed May 18, 1992. From examiner's rejection of all claims in application, in office action that was not made final, applicant appeals. Affirmed in part; Stoner, administrative patent judge, concurring in part and dissenting in part in separate opinion; McQuade, administrative patent judge, dissenting in separate opinion. [Editor's Note: The Board of Patent Appeals and Interferences states that, paragraph

¹ Plaintiff cites the Ninth Circuit's *Ackenley Fiction Picture* case to support its state law infringement claim. 94 F.2d 1466, 19 USPQ2d 4911. In that case, a company produced a gold-colored award statuette almost identical to the famous Oscar awards given each year. Id. at 499-50. The "only significant differences between the two [were that] the Stat Award is two inches shorter than the Oscar, and holds a star other than a sword." Id. Unlike that case, defendants have not copied Barbie's design as a doll or even any of the music (Mallet) puts out under her name. Defendants are parodying Barbie, not "whittling away" at consumers' ability to distinguish between competing brands.

46 USPQ2d

Ex parte Lenoine

to the board's Standard Operating Procedure No. 94-02, "the opinion below has been designated as precedential on the sole issue of the construction of 35 U.S.C. §134."]

James L. Rowland, of Greenblum & Bernstein, Reston, Va., for applicant.

Before McKelvey, chief administrative patent judge, and Stoner, Meister, McQuade, and Schaefer, administrative patent judges.

Per curiam.

This appeal was initially argued on March 13, 1994, before a merits panel consisting of Judges Stoner, Meister, and McQuade. The panel was unable to reach a decision. Judge Stoner would have reversed, Judge Meister would have affirmed, and Judge McQuade would have dismissed for lack of jurisdiction. Thereafter, an expanded five-member panel consisting of Chief Judge McKelvey and Judges Stoner, Meister, McQuade, and Schaefer voted to rehear the appeal. The appeal was reheard on June 20, 1994.

The expanded panel has reached a split decision. By a vote of 4-1, the expanded panel determines that the Board has jurisdiction. Judge McQuade dissents. By a 3-2 vote, the expanded panel affirms on the merits. Judge Stoner dissents. Judge McQuade declines to participate on the merits. Judge Schaefer's majority opinion, Judge Stoner's dissent on the merits, and Judge McQuade's dissent on jurisdiction follow.

Schaefer, administrative patent Judge,

Applicant avails itself of the first rejection of claims 24 to 52 and 54 to 58, all the claims in the application, and its parent application. 07/639,995.

The parent application was originally filed with claims 1-22. In the first Office action the examiner made a variety of formal objections, rejected all the claims for indefiniteness under 35 U.S.C. § 112, ¶ 2, and rejected claims 1-8, 16 and 17 under 35 U.S.C. § 103. In the latter rejection the examiner relied upon a combination of the teachings of Kuchler and Smolka, as evidence that the claimed subject matter would have been obvious.

In response to the rejection, applicant, *inter alia*, canceled all the claims (claims

Ex parte Lenoine

transmitted between said intermediate support plate and the ski.

(G) means for longitudinally displacing said at least one support element beneath said intermediate support plate and between said intermediate support plate and the ski for selectively adjusting longitudinal positions of said at least one support element; and

(D) means for immobilizing said at least one support element in predetermined longitudinal positions between said intermediate support plate and the ski.

(d) comprising means for vertically retaining said intermediate support plate relative to said ski.

The examiner made three rejections:

1. The rejection of claims 24, 25, 31-52, and 54-55 under 35 U.S.C. § 112, second paragraph as indefinite.
2. The rejection of claims 24-27, 31-33, 43-45 and 54-58 under 35 U.S.C. § 103 as unpatentable over the combination of the teachings of the Kuchler and Smolka, patents; and
3. The rejection of claims 28-30, 36 and 42 under 35 U.S.C. § 103 as unpatentable over the combined teachings of the Kuchler, Smolka and Weigl patents.

The board also *sua sponte* raised the question of whether "any of [applicant's] claims had been twice rejected" as required by 35 U.S.C. § 134 and thus whether the jurisdiction of this board was properly invoked.

Procedural History

Because of the jurisdictional issue, we review the relevant procedural history of this application and its parent application. 07/639,995.

The parent application was originally filed with claims 1-22. In the first Office action the examiner made a variety of formal objections, rejected all the claims for indefiniteness under 35 U.S.C. § 112, ¶ 2, and rejected claims 1-8, 16 and 17 under 35 U.S.C. § 103. In the latter rejection the examiner relied upon a combination of the teachings of Kuchler and Smolka, as evidence that the claimed subject matter would have been obvious.

In response to the rejection, applicant, *inter alia*, canceled all the claims (claims

Kuchler 4,804,209 February 14, 1989
Smolka et al. 3,797,864 March 9, 1974
Weigl 4,251,090 February 17, 1981

Ex parte Lenoine

46 USPQ2d

respect to the request to withdraw the hold, and submitted new claims 23-53. The inventor issued a final Office action, rejecting claims 23-53 as indefinite under 35 U.S.C. § 112, 12, and rejecting claims 23-27, 31-34, 43-45 and 53 as being directed to a matter which would have been obvious over the combined teachings of Kuchler and Smolka references. Claims 36 and 42 were also rejected under 35 U.S.C. § 103 as unpatentable in view of the cited teachings of Kuchler, Smolka and al. The examiner noted that applicant did not separately argue the features of the patent claims and that the patentability of dependent claims stood or fell with the parent claims.

Applicant responded to the final rejection with an appeal, and a proposed amendment on the basis that the amendment raised new issues and did not simplify the number of issues on appeal. Applicant filed another proposed amendment. The examiner again denied entry of an amendment on the basis that the amendment was not in compliance with 37 CFR § 6(b), raised new issues and did not materially reduce or simplify the issues for examination.

After submitting an appeal brief, applicant chose to refute the application as a "writter continuation" (FWC) under 37 CFR § 1.62. By a preliminary amendment, applicant canceled claims 23 and 53, and claims 34-38 and made minor amendments to claims 24-26, 28, 29, 31-33, 36, 37, and 43-46.

The examiner essentially reiterated the grounds of rejection. Claims 24, 25, 34, 35 and 55 were rejected as indefinite under 35 U.S.C. § 103 as unpatentable in view of the combined teachings of Kuchler, Smolka and Weigl. The Office action was not made final.

In response applicant filed a notice of appeal and subsequently filed a proposed amendment. The examiner held the application to be abandoned. He felt the notice of appeal was improper at the particular stage of the prosecution, citing 35 U.S.C. § 134 (137 CFR § 1.19). He also felt that the amendment was unpatentable under 37 CFR §§ 1.135 and 1.136.

Applicant filed a paper captioned "Request to Withdraw Holding of Abandonment and Provisional Petition to Revive." With

the filing of the paper, applicant appealed the rejection and we have jurisdiction. Does the Board of Patent Appeals and Interferences have jurisdiction (35 U.S.C. § 134); under the circumstances of this case, including the fact that an appeal to this continuing application was taken from a first Office action which was not denied by the Primary Examiner, as a final rejection.

Applicant briefed the issue and appeared at an additional hearing held before the expanded panel on June 20, 1994.

Jurisdiction

Section 134 of Title 35 gives applicants the statutory right to an administrative appeal. The section provides:

An applicant for a patent, any of whose claims have been twice rejected, may appeal from the decision of the primary examiner to the Board of Patent Appeals and Interferences.

Jurisdiction for this appeal depends on whether applicant is an applicant "any of whose claims has been twice rejected." We note that this should be claims 24-32, claim 53 having been canceled.

1423

Ex parte Lenoine

conclude that applicant had the right to appeal the rejections and we have jurisdiction.

To reach a decision requires us to construe the word "claims" as used in § 134. The word is susceptible to at least two interpretations. It can refer to the claims of an application, i.e., the "one or more claims particularly pointing out and distinctly claiming the subject matter" of the invention required by 35 U.S.C. § 112, ¶2. Or the word can be used in a more general sense to refer to claims "for a patent," as it is used in 35 U.S.C. § 132. In this latter sense, the word is synonymous with a request or demand for a patent.

[1] Section 134 merely uses the word "claims." We must, therefore, decide which construction to give to the statute. We conclude that "claims" in § 134 should be construed consistently with its use in § 132 to mean "claims for a patent" rather than particular "claims of an application."

[2] Section 134 is part of Chapter 12 of Title 35. Chapter 12 is titled "Examination of Applications" and sets forth the general procedures to be followed in the Office for examination. Sections 131 to 134 provide the general procedures relating to *ex parte* examination. In relevant part, these sections specify that (1) an examination shall be made (§ 131); (2) if "any claim for a patent" is rejected, the applicant shall be informed of the bases of the rejection (§ 132); (3) if the applicant persists in the "claim for a patent" with or without amendment (§ 132); and (4) if the applicant's claims have been twice rejected (§ 132); and (4) if the applicant may appeal (§ 134). Considering these sections together, we conclude that the "claims" as used in § 134 is a reference to the repeated "claim for a patent" as used in § 132, rather than a reference to a particular claim "of an application." Under our interpretation, so long as the applicant has twice been denied a patent, an appeal may be filed. So construing the statute, we conclude that applicant's claims for a patent have been twice rejected. Applicant has been denied a patent three times. Applicant, therefore, had the right to appeal and we, accordingly, have jurisdiction.

We do not view these cases as being inconsistent with our interpretation of the statute. In each case, the applicant's claim for a patent was twice denied. We believe the dissent erred in interpreting the court's rationale as stating necessary, rather than sufficient conditions for jurisdiction. The Federal Circuit has cautioned against extending general principles to cases having different factual situations. *FMC Corp. v. Manafortowac*, 835 F.2d 1411, 1417 n.12, 5 USPQ2d 1112, 117 n.12 (Fed. Cir. 1997).

The dissent also errs in construing "any of whose claims" as having been twice rejected. We mean "any of whose claims, which do not differ in substance and scope from previously rejected claims, has been twice rejected." There is simply no support for this limited view in the statute.

Judge McQuade's dissent on jurisdiction

Judge McQuade's dissent argues that we have failed to provide authority for our interpretation of § 134, this is incorrect since the authority is Chapter 12, of Title 35. We have construed "claims" in § 134 *in pari materia* with the other sections of that Chapter and the examination scheme of Chapter 12 as a whole. Sections 132 and 134 were promulgated at the same time and both are part of the statutory framework setting forth the procedures for the patent examination process. Accordingly, the two sections should be interpreted *in pari materia*. *Eisenbergh v. United States*, 409 U.S. 239, 243, 93 S.Ct. 477, 480 (1972). It is appropriate, therefore, to give the word the same meaning in both sections. Our construction is also consistent with the principle that statutes giving the right to appeal are to be literally construed. *United States v. Mauder Chemical Corp.*, 576 F.2d 368, 374 (CCPA, 1978).

The dissent argues that our construction is inconsistent with the "construction which traditionally has been accorded" 35 USC § 134.

The dissent relies on *In re Seagren*, 422 F.2d 443, 164 USPQ 632 (CCPA 1970) and *In re Hengenhold*, 440 F.2d 1395, 169 USPQ 473 (CCPA 1971). In *Seagren* the court noted:

Those sections [132 and 134] do not require that each and every claim presented during the prosecution of an application must be twice examined and twice rejected on the same ground. Section 134 appears to imply the contrary since it permits an appeal [to be taken when any claim has been twice rejected]. Nevertheless, the claims here in question have been twice rejected, contrary to appellants' allegations, since the examiner rejected them on the grounds of undue multiplicity and as being based on new matter prior to the rejection in his Answer. [Emphasis original.]

422 F.2d at 446, 164 USPQ at 635. In *Hengenhold*, the court noted that

it is clear that, for the board to have some jurisdiction in a case, only one claim need be twice rejected, and that even occurred here. [Emphasis original.]

440 F.2d at 1403, 169 USPQ at 479.

We do not view these cases as being inconsistent with our interpretation of the statute.

In each case, the applicant's claim for a patent was twice denied. We believe the dissent erred in interpreting the court's rationale as stating necessary, rather than sufficient conditions for jurisdiction. The Federal

Circuit has cautioned against extending general principles to cases having different factual situations. *FMC Corp. v. Manafortowac*, 835 F.2d 1411, 1417 n.12, 5 USPQ2d 1112, 117 n.12 (Fed. Cir. 1997).

The dissent also errs in construing "any of whose claims" as having been twice rejected. We mean "any of whose claims, which do not differ in substance and scope from previously rejected claims, has been twice rejected." There is simply no support for this limited view in the statute.

The § 112 rejection. The examiner has rejected claims 24-25, 2, 54 and 55 under 35 U.S.C. § 112, 2nd paragraph as indefinite. The examiner indicates that these claims only positively distinctly claim the interconnection of binding leaving the positive "interconnection of the other safety binding down." In use, the support element transmits forces between the boot and upper surface of the ski. The apparatus also includes a means for mounting the support element for selective positioning relative to the plate. The examiner presents two rejections directed to two groups of claims, (1) Claims 24 to 27, 31 to 33, 43 to 45 and 54 to 58 under 35 U.S.C. § 103 as unpatentable over the combination of the teachings of Kuchler and Smolka; and (2) Claims 28 to 30, 36 and 42 under 35 U.S.C. § 103 as unpatentable over the teachings of these same patents combined with the disclosure in Weigl.

In presenting the appeal, applicant has separately addressed each rejection, but has not separately basened the patentability of the claims within each group. Accordingly, the claims in each group stand or fall together. 37 CFR § 1.182(c)(5); *See Goodwin, 11 F.3d 1046, 1053, 29 USPQ2d 2010, 2013 (Fed. Cir. 1993); In re King, 801 F.3d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Serrakor, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983); In re Kastow, 707 F.2d 1366, 1376, 217 USPQ 1089, 1096 (Fed. Cir. 1983); In re Albrecht, 579 F.2d 92, 93-94, 198 USPQ 208, 209 (CCPA 1978).* Where an applicant does not "point out what relevance the additional limitations have to the patentability of the narrower claims," the claims will stand or fall together even if applicant asserts that the claims do not stand or fall together. *In re Heffert, 461 F.2d 1390, 1391, 174 USPQ 259, 260 (CCPA 1972).*

The 35 U.S.C. § 103 rejection based on Kuchler and Smolka

The closest prior art of record is the Kuchler patent. Kuchler relates to a ski which is said to be both shock absorbing and have improved sliding performance. Col. 1, lines 45-48. Kuchler's ski includes two separated portions which are joined together to form a torsion-resistant "box." Col. 1, lines 52 to 55. Figures 1, 2, 5 and 6 show examples of the box. The box can be an integral part of the ski structure as shown in Figure 5 or attached to the top surface of the ski as shown in Figure 1.

The 35 U.S.C. § 103 rejections

(1) We note that the examiner's contention to be more in the nature of a lack of entitlement under 35 U.S.C. § 112, first paragraph, or imperfections under 35 U.S.C. § 101. We express no comment, in this opinion, on any grounds of rejection which were not brought before us.

shown in Figure 1. The box has an upper portion or surface 2. This upper portion can be used, totally or partially, as a binding plate for the ski bindings. Col. 4, lines 63-66.

The box includes torsion-resistant connections made by spacers 6 and 7. E.g., col. 3, lines 49-55. In the summary of the invention section of the patent, Kuchler describes the function of the spacers (Col. 2, lines 16-32). The torsion-resistant connection between the body portions, according to the invention, is effected by spacers which are arranged correspondingly at intervals, in front and in the back of the binding. Preliminarily, these spacers are displaceable, and namely in the longitudinal direction of the body portion. Thus, a simple, individual adjustment of the gliding device is possible.

The spacers can be detachably connected to the body portions. Through the modification of the distance between the displaceable spacers or of the height of the spacers, by corresponding replacing thereof, the damping characteristics can also be modified. This is of particular importance in the case of an alpine ski, since the ski can be adjusted optionally according to the weight and the skill of the skier.

(Emphasis added.)

Thus, Kuchler teaches the concept of utilizing displaceable spacers to adjust the characteristics of the ski. The difference between Kuchler and the claimed subject matter is the failure of Kuchler to disclose a specific mechanism for attaching the spacers at the desired location. However, based on the level of ordinary skill in the art as represented by the references before us, we feel that one having ordinary skill in the art would have no trouble adapting readily available attachment means to this end. The person of ordinary skill in the art is presumed to know something about the art apart from what the references expressly disclose. *In re Jacoby, 309 F.2d 513, 516, 135 USPQ 317, 319 (CCPA 1962).* We conclude that it would have been obvious to include a conventional means for mounting or securing the supports or spacers on Kuchler's apparatus.

The examiner relied on the Smolka patent for the teaching of the use of safety bindings on a raised intermediate support plate. Smolka shows a ski having binding parts 1 and 2, mounted on a rigid binding plate 1 on a raised intermediate support plate. Figures 1 to 6 and Col. 1, lines 46 to 47. In light of Kuchler's teaching that the upper portion of the torsion box may take up the function of the binding plate (Col. 4, lines 63-66), it would have been obvious to attach bindings to Kuchler's upper plate. In this

regard, we note that applicant's claims do not require bindings. Rather, the claims indicate that the intended use of the intermediate plate is to support or act as 2 mounting for the bindings. See, for example, claims 26 and 56. In any event, to the extent the claims require or read on the inclusion of bindings, the subject matter would have been obvious over the combined teachings of Kuchler and Smolka.

In reaching this conclusion we have carefully considered applicant's arguments but have not been persuaded of error in the examiner's rejection. We fundamentally disagree with applicant's assertions as to the teachings of the Kuchler patent. Kuchler, in our view, teaches the use and positioning of spacers under a boot supporting plate or surface to affect the handling characteristics of the skis. Col. 2, lines 6-32.

The rejection of claims 24 to 27, 31 to 33, 43 to 45 and 54 to 58 is affirmed.

The rejection based on Kuchler, Smolka and Weigl

Claims 28 to 30, 36 and 42, recite an additional difference when compared with the Kuchler patent. These claims additionally require the inclusion of a means for restraining the amount of movement between the intermediate support plate and the ski. The examiner relies on the Weigl patent to show that the use of such means is old in the art. In the Answer the examiner states:

Weigl is solely relied upon by the examiner to show the old and well-known use of an assembly to limit the vertical movement of a ski binding plate assembly as set forth in the office action (paper [N]o. 21). Such centrally located pivoted support parts (3) are conventional in the art and widely utilized when a control or limit of the binding plate is necessary or desired for safety reasons.

The examiner concluded that it would have been obvious since restraint with respect to Kuchler's system.

Applicant argues that the incorporation of means to limit vertical movement would not have been obvious since the support elements would need to be positioned between Weigl's plate and the upper portion of the ski body which would interfere with the operation of the Weigl arrangement. It is also argued that incorporation of the Weigl arrangement would not enhance torsional resistance. Thus, it is argued one of ordinary skill in the art would not have incorporated Weigl's arrangement into Kuchler's support structure. We agree with the examiner that the subject matter of claims 28 to 30, 36 and 42

Ex parte Lemoine

46 USPQ2d

46 USPQ2d

it have been obvious from the combined teachings of the references. The nature of the art is and the references cited by the examiner demonstrate the high level of mechanical ingenuity demonstrated by those working in the art. We find that the level of ordinary skill in the art would include the ability to make adaptations necessary to incorporate Weig's device into Kuchler's ski while retaining its desirable control functions. The art would fail to add Weig's arrangement to obtain benefits described in the first two columns of Weig's patent.

AFFIRMED-IN-PART.

Stoner, administrative patent judge, concurring-in-part and dissenting-in-part.

I agree with the view stated in the majority opinion that the jurisdiction conferred on the Board of Patent Appeals and Interferences by 33 U.S.C. § 124 has been properly invoked in this appeal by the patent applicant Philippe Lemoine ("Lemoine" or "applicant"), although my agreement is based on different reasons than those expressed in the majority opinion. I share the view of the subject matter of claims 24 through 27, 31 through 33, 43 through 45 and 54 through 58 with the majority's determination that the rejection of claims 24, 25, 31 through 52, 54 and 55 for indefiniteness under 35 U.S.C. § 112, second paragraph, must be reversed. I disagree, however, with the majority's determination that the subject matter of claims 24 through 27, 31 through 33, 43 through 45 and 54 through 58 would have been obvious from the teachings of Kuchler and Smolka and that the subject matter of claims 28 through 30, 36 and 42, 45, and that the spacers allow optimal adjustment for the particular skier (Col. 2, lines 16-32) and (2) limiting the disclosure to specific embodiments and drawings. As indicated by the CCPA:

"It is axiomatic that a reference must be considered in its entirety, and it is well established that the disclosure of a reference is not limited to specific working examples contained therin." *In re Proctor*, 681 F.2d 792, 794 n.1, 215 SP 569, 570 n.1 (CCPA 1982). A reference by way of technology, EWP Corp. v. *Siemens Universal Inc.*, 755 F.2d 898, 907, 5 USPO 20, 25 (Fed. Cir.), cert. denied, 44 U.S. 843 (1985). Consideration of the reference in its entirety, including both the summary of the invention and the specific examples, leads us to conclude that the claimed subject matter would have been obvious.

Judge Stoner's dissent on obviousness
Judge Stoner dissects from our conclusion that the spacers are dispensable in the prior art. He errs in (1) giving esse-
ntial weight to Kuchler's express teaching
that the spacers are dispensable in the
judicial direction to provide a simple
mutual adjustment to provide (2) de-
tachably connected to the body por-
tion, and that the spacers allow optimal
adjustment for the particular skier (Col. 2,
lines 16-32) and (2) limiting the disclosure to
specific embodiments and drawings. As
indicated by the CCPA:

"It is axiomatic that a reference must be considered in its entirety, and it is well established that the disclosure of a reference is not limited to specific working examples contained therin." *In re Proctor*, 681 F.2d 792, 794 n.1, 215 SP 569, 570 n.1 (CCPA 1982). A reference by way of technology, EWP Corp. v. *Siemens Universal Inc.*, 755 F.2d 898, 907, 5 USPO 20, 25 (Fed. Cir.), cert. denied, 44 U.S. 843 (1985). Consideration of the reference in its entirety, including both the summary of the invention and the specific examples, leads us to conclude that the claimed subject matter would have been obvious.

Conclusion

For the above-stated reasons (1) we con-
clude that we have jurisdiction to decide this
issue and (2) we reverse the rejection of claims 24 through 58.

Ex parte Lemoine

1427

The present application is a file wrapper continuation (FWC) application of Serial No. 07/639,995 (the '095 application). As filed, the '095 application included claims 1 through 22, directed to an apparatus for mounting a boot upon a ski.

After receiving an Office action¹ rejecting claims 1 through 22 under 35 U.S.C. § 112, second paragraph, and some of the claims under 35 U.S.C. § 103 as unpatentable over Kuchler in view of Smolka and Weig² in the earlier application, the same rejection applied to the like numbered claims in the present application. That no claim, including none of claims 24 through 52, has retained identical wording through two separate Office actions³ should not and does not, in my view, deprive Lemoine of his right to appeal from the Office action mailed July 17, 1992.⁴

Where, as here, the examiner's rejection (and underlying evidence in the form of references) remains unchanged through at least two actions on the merits, despite amendments to the claims, there is no reasonable purpose served by forcing an applicant like Lemoine to request reconsideration without further amendment prior to exercising the right to appeal conferred by 35 U.S.C. § 134.⁵ In my view, to read the statute as though it requires this futile act ill serves the applicant, for whom the right of appeal has been created by statute. Additionally, such a reading departs from a common sense understanding of what "any of whose claims has been twice rejected" means in this context. It is on this basis that I would hold that we possess jurisdiction to decide the present appeal.⁶

I set out next to take the view, expressed in the majority opinion, that the word "et ceteris" in § 134 means something other than what that term is ordinarily understood to mean in the patent application examination process, that is, those claims "particularly pointing out and distinctly claiming the subject matter which the inventor regards as his invention," with which a specification is required

¹By virtue of a change to the language of the independent claim from which it depends, the language of a dependent claim may be likewise construed to have changed, even though the dependent claim is otherwise not amended. While one might envision situations in which the only thing remaining from an earlier claim is its claim number, with all the language and claimed subject matter having been changed, that is not the case here.

²Indeed, the fact that the examiner has seen no need to alter the basis for rejection demonstrates that virtually the same subject matter has been repeatedly claimed and rejected.

³Mailed April 3, 1991.

⁴Amendment filed July 3, 1991.

⁵Mailed October 18, 1991.

⁶Filed February 18, 1992.

⁷Filed May 18, 1992.

5 U.S.C. § 112, second paragraph, to include. Construing the word "claims" in § as though synonymous with "reqests or aids for a patent", may lead to appeals in trials which are presently not envisioned quite removed from the kind of situation before us.

The § 103 rejections

(i) all due respect to my colleagues in majority and to the examiner, I cannot say that the combined teachings of claims 54, 35 and 56 obvious. Nor do I anything in the teachings of Weigl, applied only against certain dependent claims which makes up for the deficiency of Shles and Smolka.

Claim 54 defines the invention as follows: "An apparatus for mounting a boot upon a ski; said apparatus comprising: (a) a boot-supporting device for supporting at least one ski binding for engagement of the at least one ski binding with the boot; (b) at least one supporting element located between said boot-supporting device and an upper surface of said ski; when said apparatus is mounted upon a ski;" defined by spacers 6 and 7.

The several embodiments discussed and illustrated by Kuchler contain no displacing spacers, much less, any means for mounting or securing these spacers in the manner required by Kuchler's independent claims. Kuchler is primarily concerned with connecting partitions of a ski to one another in a torsion-resistant manner (column 1, lines 45-58).

With regard to the embodiments of figures 1, 5 and 6, Kuchler discloses that connection of the upper body portion 2 to the lower body portion is achieved:

"...via the spacers 6, 7 whereby the two body portions 2, 3 are either directly connected through the spacers 6, 7 as in FIG. 1, or, as shown in FIG. 5, through an additionally provided transition of the upper body portion 2 into the lower body portion 3. A further possible construction of the torsion resistant box 49 is shown in FIG. 6. There, an additional body portion 48 is provided, which together with the upper portion 2 and the spacers 6, 7 form the torsion-resistant [sic, torsion-resistant] box 49 [column 5, lines 49-60]."

Kuchler makes no mention of adjustability of the spacer location in connection with these embodiments. Again with distinguishing emphasis added:

56. An apparatus for mounting a boot upon a ski; said apparatus comprising: (a) a boot-supporting device for supporting at least one ski binding for engagement of the at least one ski binding with the boot;

(b) at least one supporting element located between said boot-supporting device and an upper surface of said ski; when said apparatus is mounted upon a ski; and (c) means for mounting said at least one support [sic, supporting] element with respect to said boot-supporting device for selective longitudinal positioning of said at least one support [sic, supporting] element relative to said boot-supporting device..

Of the three references upon which the examiner has relied, Kuchler is, without a doubt, the closest prior art. Each illustrated embodiment of Kuchler's skis includes, as recited in claim 56, "a boot-supporting device for supporting at least one ski binding for engagement of the at least one ski binding with the boot" defined by the "upper body portion" 2. Likewise, each illustrated embodiment of Kuchler's skis includes, as recited in claim 56, "at least one supporting element located between said boot-supporting device and an upper surface of said ski; when said apparatus is mounted upon a ski;" defined by spacers 6 and 7.

The several embodiments discussed and illustrated by Kuchler contain no displacing spacers, much less, any means for mounting or securing these spacers in the manner required by Kuchler's independent claims. Kuchler is primarily concerned with connecting partitions of a ski to one another in a torsion-resistant manner (column 1, lines 45-58).

With regard to the embodiments of figures 1, 5 and 6, Kuchler discloses that connection of the upper body portion 2 to the lower body portion is achieved:

"...via the spacers 6, 7 whereby the two body portions 2, 3 are either directly connected through the spacers 6, 7 as in FIG. 1, or, as shown in FIG. 5, through an additionally provided transition of the upper body portion 2 into the lower body portion 3. A further possible construction of the torsion resistant box 49 is shown in FIG. 6. There, an additional body portion 48 is provided, which together with the upper portion 2 and the spacers 6, 7 form the torsion-resistant [sic, torsion-resistant] box 49 [column 5, lines 49-60]."

Kuchler makes no mention of adjustability of the spacer location in connection with these embodiments.

"The embodiment disclosed in figure 4 of Kuchler provides that the spacers may be mounting or securing the supports on trapezoidally shaped. Kuchler makes no mention of adjustability of the spacer location in connection with this embodiment.

"The embodiment disclosed in figure 7 of Kuchler simply provides that the space between body portions 2 and 3, occupied in part by spacer 4, 5, 6 and 7, may be closed by a sponge rubber plate 14. Kuchler makes no mention of adjustability of the spacer location in connection with this embodiment.

"At first glance, Kuchler's figures 2 and 8 appear to have something to do with adjustment of spacers. The descriptions of these figures show that first impression to be erroneous. The description with regard to figure 8 reads as follows (emphasis added):

"FIG. 8 shows an embodiment wherein the upper body portion 2 is given the possibility to move in longitudinal direction, with respect to the lower body portion 3. Here the spacers 6, 7 are provided with a guide peg 35 whose neck 36 passes through a longitudinal slot 19 of the upper body portion 2. This longitudinal slot 19 is formed in an elastic material 31, so that between the neck 36 and the lateral walls 33 of the longitudinal slot 19 there is practically no clearance left."

"More specifically, when the two body portions 2, 3 are displaced longitudinally with respect to each other, this movement is purposefully damped by the elastic material 34, respectively the conformation of the longitudinal slot 19 which results in a safe guidance of the upper body and in the preservation of the torsion-resistant box, as a whole [column 6, lines 28-44]."

The description of the embodiment of figure 2 at column 5, line 61 through column 6, line 6 reveals nothing about any movement of the spacers, much less about the structure which appears to protrude from the top of each of spacers 6 and 7 in figure 2, and might be thought to resemble the peg 35 of figure 8. It is unquestionable true that Kuchler's "SUMMARY OF THE INVENTION" makes reference to spacers which are "displaceable" in the longitudinal direction of the "body portion" and states that modification of the distance between displaceable spacers permits the damping characteristics of a ski to be adjusted to an optimal value according to the weight and skill of a skier (column 2, lines 16 through 32). In hindsight, knowing what we do of the appellant's disclosed invention, it is tempting to conclude that Kuchler's spacers are intended to be displaceable in the same manner as the appellant's claimed supporting element and that the spacers would be provided with the

"The embodiment disclosed in figure 4 of Kuchler provides that the spacers may be mounting or securing the supports on trapezoidally shaped. Kuchler makes no mention of adjustability of the spacer location in connection with this embodiment.

"The embodiment disclosed in figure 7 of Kuchler simply provides that the space between body portions 2 and 3, occupied in part by spacer 4, 5, 6 and 7, may be closed by a sponge rubber plate 14. Kuchler makes no mention of adjustability of the spacer location in connection with this embodiment.

"At first glance, Kuchler's figures 2 and 8 appear to have something to do with adjustment of spacers. The descriptions of these figures show that first impression to be erroneous. The description with regard to figure 8 reads as follows (emphasis added):

"FIG. 8 shows an embodiment wherein the upper body portion 2 is given the possibility to move in longitudinal direction, with respect to the lower body portion 3. Here the spacers 6, 7 are provided with a guide peg 35 whose neck 36 passes through a longitudinal slot 19 of the upper body portion 2. This longitudinal slot 19 is formed in an elastic material 31, so that between the neck 36 and the lateral walls 33 of the longitudinal slot 19 there is practically no clearance left."

"More specifically, when the two body portions 2, 3 are displaced longitudinally with respect to each other, this movement is purposefully damped by the elastic material 34, respectively the conformation of the longitudinal slot 19 which results in a safe guidance of the upper body and in the preservation of the torsion-resistant box, as a whole [column 6, lines 28-44]."

The description of the embodiment of figure 2 at column 5, line 61 through column 6, line 6 reveals nothing about any movement of the spacers, much less about the structure which appears to protrude from the top of each of spacers 6 and 7 in figure 2, and might be thought to resemble the peg 35 of figure 8. It is unquestionable true that Kuchler's "SUMMARY OF THE INVENTION" makes reference to spacers which are "displaceable" in the longitudinal direction of the "body portion" and states that modification of the distance between displaceable spacers permits the damping characteristics of a ski to be adjusted to an optimal value according to the weight and skill of a skier (column 2, lines 16 through 32). In hindsight, knowing what we do of the appellant's disclosed invention, it is tempting to conclude that Kuchler's spacers are intended to be displaceable in the same manner as the appellant's claimed supporting element and that the spacers would be provided with the

"The majority has quietly abandoned most, if not all, of the position taken by the examiner in his statement of the rejection in the Office action mailed July 17, 1992, and the answer mailed October 4, 1993. The examiner appears to have bottomed his reticulation on Kuchler's figure 8 embodiment, while mixing in comments pertaining to other embodiments.

"The majority has quietly abandoned most, if not all, of the position taken by the examiner in his statement of the rejection in the Office action mailed July 17, 1992, and the answer mailed October 4, 1993. The examiner appears to have bottomed his reticulation on Kuchler's figure 8 embodiment, while mixing in comments pertaining to other embodiments.

Filed June 17, 1993.

١٤٣

Ex parte Lemoine

46 USPQ2d

۴۶

Ex parte Lemoine

body portion, while with respect to the upper body portion, they are longitudinal and removable to a limited extent and lateral: guideable. The upper body portion carrying the binding can thus move with respect to the lower body portion carrying the binding surface, so that shocks can be absorbed not only in a vertical direction, but also in a horizontal direction. . . . The longitudinal mobility is achieved, for instance, by the fact that the spacers are held in slots in the upper body portion or have pegs guided in these slots, so that the torsion-resistant construction is preserved.

column 3, lines 37-51; emphasis added.]

[We also recognize that we are to presume on the part of the worker, rather than conversely. See *In re Sovish*, 769 F.2d 738, 11 USPQ2d 271 (Fed. Cir. 1985). We are not, however, authorized to speculate as to what having ordinary skill in the art would have understood a reference to mean; particularly when that speculation is guided by an appellant's own disclosure. Our court of review has repeatedly cautioned against employing hindsight by using an applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings in prior art. See, e.g., *Growth Processing Corp. v. American Maize-Products Co.*, 840 F.2d 1060, 1063, 3 USPQ2d 1788, 1792 (Fed.

(see Paper No. 4). Claims 23 through 53 were rejected in a "final" Office action dated October 18, 1991 (Paper No. 7). The parent application was subsequently abandoned in favor of the instant flexible-wrapping continuation application. By way of a preliminary amendment, the applicant canceled claims 23 and 53, the two independent claims finally rejected in the parent application, and added new claims 54 through 58, with claims 54 through 56 being independent claims. (See Paper No. 20.) Claims 24 through 52 and 54 through 58 were rejected in a "non-final" Office action dated July 17, 1992. (Paper No. 21.) The present appeal was taken from this "non-final" Office action (see Paper No. 24).

By virtue of the amendments made by the appellant in response to the Office action issued in the parent application, the claims rejected in the "non-final" Office action appealed from differ in substance or scope from the claims which had been rejected in the parent application. As conceded by the appellant,

[t]he independent claims entered in the parent application (claims 1, 23 and 53) and the independent claims entered in the instant continuation application (claims 54, 55 and 56), have been reviewed. The wording of the continuation claims is in

McQuade, administrative patent judge, dissenting.

This appeal is premature and should be dismissed without a decision on its merits. The pertinent facts are not in dispute. In parent application Serial No. 07 /639,095, filed January 1, 1937, claims 1 through 22 were

33 USC 134 Appeal to the Board of Patent Appeals and Interferences

An applicant for a patent, any of whose claims has been twice rejected, may appeal from the decision of the primary examiner to

statutory right of appeal is supplemented by 37 CFR 1.19(f) which provides in pertinent part, that "[e]very applicant for a patent . . . may file any of the claims of which have been twice rejected or who has been given a final rejection (§ 1.113), may . . . appeal from the decision of the examiner to the Board of Patent Appeals and Interferences." Thus, in order for this Board to have jurisdiction in an appeal, at least one of the appealed claims must be twice rejected or the claims must be under final rejection. In the present case, none of the claims on appeal has been twice rejected and the decision of the examiner appealed from was not a "final" rejection. This appeal is therefore premature and this Board does not have jurisdiction to render a decision on its merits.

The majority's determination that they have jurisdiction to decide the appeal under 35 USC 134 is predicated on their construction of the word "claims" as it appears in this statutory provision as referring to a general request or demand for a patent, rather than to claims of the type required by 35 USC 112, second paragraph. According to the majority, this interpretation is consistent with the usage of the term "claims" in 35 USC 132. In this light, it is rationalized that since the applicant's "claim" or demand/request for a patent has been denied or rejected at least twice (actually three times), 35 USC 134 affords the applicant the right to appeal to this Board.

The majority, however, has failed to advance any authority for what is, at best, a strained interpretation of the statutory language in question. The fact that this language includes the modifier "any" in conjunction with the plural term "claims" would seem to plainly and unambiguously indicate that 35 USC 134 refers to "claims" of the type required by 35 USC 112, second paragraph, not a general demand or request for a patent, and that at least one of such claims must be twice rejected [or an applicant to have a statutory right to appeal] the examiner's decision to this Board. This is the construction which traditionally has been ac-

majority has construed it, there never would have been any need for the foregoing provision in 37 CFR 1.191(a) since an applicant would have had a statutory right to appeal to this Board upon any second or subsequent rejection of his or her demand/request for a patent irrespective of whether such rejection was a "legitimate" rejection.

Finally, the majority has relied on the principles that related statutory provisions should be interpreted in *mero materialis* and *mero iurecionali*.

PAGE 15/22 * RCVD AT 3/11/2005 2:32:42 PM [Eastern Standard Time] * SVR:USPTO-EFXRF-1/7 * DNI5:8729306 * CSID:8013558938 * DURATION (mm:ss):09:32

1432

Ex Parte Lemoine

46 USPQ2d

that statutes giving the right of appeal should be liberally construed to support their position on the jurisdictional issue. Neither of these principles, however, justifies interpreting 35 USC 134 in a manner which is completely inconsistent with the plain and unambiguous meaning of the language therein. That it might be desirable from a policy standpoint to expand the right of appeal to this Board to cover fact situations similar to that here involved is of no moment. Moreover, the implementation of such a policy is better left to the rule making authority of the Commissioner, rather than to dubious statutory constructions of the type engaged in by the majority.